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In re Patent of Fedorkin et al.	:	DECISION ON APPLICATION
Patent No. 7,491,509	:	FOR RECONSIDERATION OF
Issue Date: February 17, 2009	:	PATENT TERM ADJUSTMENT
Application No. 10/770,600	:	AND NOTICE OF INTENT TO
Filing Date: February 3, 2004	:	ISSUE CERTIFICATE OF
Attorney Docket No. 24990-0005001	:	CORRECTION

This is a decision on the petition filed on April 16, 2009, which is being treated as a petition under 37 C.F.R. § 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by five hundred sixty (560) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by five hundred sixty (560) days is **GRANTED to the extent indicated herein**.

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 C.F.R. § 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under 37 C.F.R. § 1.136.

Issue #1

The first issue in this case is the amount of Office delay under 35 U.S.C. § 154(b)(1)(B) ("B Delay"). Patentees assert the amount of B Delay is 213 days.

The application was filed February 3, 2004. A request for continued examination ("RCE") was filed September 4, 2007.

As the period from the filing date of the request for continued examination ("RCE") to the issue date of the patent is not included in the "B" delay period, the over three year period began on February 4, 2007, and ended on September 3, 2007, *the day before* the RCE was filed, and is 212 (not 213) days. See 35 U.S.C. § 154(b)(1)(B)(i).

Issue #2

The second issue in this case is the extent to which the Office should have increased the patent term adjustment as a result of B Delay when issuing the patent.

When issuing the patent, the Office increased the patent term adjustment by 110 days for B Delay. Patentees contend the Office should have increased the patent term adjustment by 213 days.

With respect to the period of adjustment for the Office taking in excess of three years to issue the patent, 35 U.S.C. § 154(b)(2)(A) limits Office delay to the sum of A Delay and B Delay to the extent such periods of delay are not overlapping. In this case, the periods of A Delay and B Delay do not overlap. Therefore, the patent term adjustment should have been increased by 212 days, the amount of B delay, instead of by 110 days.

Issue #3

The third issue in this case is the extent to which the amount of Applicant Delay should have been increased pursuant to 37 C.F.R. § 1.704(b) as a result of delay in the filing of a reply to the Notice to File Missing Parts mailed on September 2, 2004.

The Office mailed a Notice to File Missing Parts on May 12, 2004. Patentees filed a reply to the Notice to File Missing Parts on September, 2, 2004. The Office notes patentees correctly assert the Office incorrectly entered the filing date of the September 2, 2004 reply as August 31, 2004.

37 C.F.R. § 1.704(b) provides for a reduction when a party takes more than 3 months to respond to any notice or action by the Office making any rejection, objection, argument or other request. Specifically, 37 C.F.R. § 1.704(b) states,

[A]n applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

The Office entered a reduction of 19 days pursuant to 37 C.F.R. § 1.704(b) for the “August 31, 2004” reply to the Notice to File Missing Parts. Patentees assert the proper amount of reduction should have been 21 days because the reply was not actually filed until September 2, 2004.

An applicant is not required to supply all items listed in a Notice to File Missing Items on the same date. For example, if the Notice indicates a fee and declaration must be filed, a party may file the file and the declaration on different dates as long as both submissions are timely. If missing items are submitted on different date, the last date of submission will be used when determining the date a reply to the Notice was filed when determining the proper amount of a reduction in patent term adjustment under 37 C.F.R. § 1.704(b). In this case, the September 2, 2004 reply did not include all of the missing items. Specifically, the September 2, 2004 papers did not include a sequence listing and related items. The sequence listing and related items were not filed until September 15, 2004, three months and 34 days after the Office mailed the Notice to File Missing Items. Therefore, the Office should have entered a 34-day reduction, instead of a 19-day reduction, for Applicant Delay under 37 C.F.R. § 1.704(b) when responding to the Notice to File Missing Parts.

Issue #4

The fourth issue in this case is the extent to which the total amount of Applicant Delay should have been increased under 37 C.F.R. § 1.704(b) as a result of delay in the filing of a reply to the non-final Office action mailed September 11, 2006.

Patentees did not file a reply to the September 11, 2006 Office action until March 16, 2007. The Office did not enter a reduction under 37 C.F.R. § 1.704(b) as a result of delay in the filing of a reply to the September 11, 2006 Office action. Patentees assert a reduction of 95 days under 37 C.F.R. § 1.704(b) appears appropriate for delay in the filing of a reply to the September 11, 2006 Office action.

The time period beginning on the day after the date three months after the Office issued the non-final Office action, September 12, 2006, until the date a reply was filed in response to the non-final Office action, March 16, 2007, is 95 days. Therefore, a 95-day reduction should have been entered under 37 C.F.R. § 1.704(b) for delay in the filing of a reply to the September 11, 2006 Office action.

Issue #5

The fifth issue in this case is the extent to which the total amount of Applicant Delay should have been increased pursuant to 37 C.F.R. § 1.704(b) as a result of delay in the filing of a reply to the Notice of Allowance mailed May 31, 2007.

The Office mailed a Notice of Allowance on May 31, 2007. A RCE and Information Disclosure Statement (“IDS”) were filed September 4, 2007. The Office did not enter a reduction under 37 C.F.R. § 1.704(b) as a result of delay in the filing of a reply to the May 31, 2007 Notice of Allowance.

The time period beginning on the day after the date three months after the Office issued the Notice of Allowance, September 1, 2007, until the date a reply was filed in response to the Notice of Allowance, September 4, 2007, is 4 days. Therefore, a 4-day reduction should have

been entered under 37 C.F.R. § 1.704(b) for delay in the filing of a reply to the May 31, 2007 Notice of Allowance.

Conclusion

The amount of A Delay is 336 days.

The amount of B Delay is 212 days.

The amount of overlapping days between A Delay and B Delay is 0 days.

The calculation of patent term adjustment on the patent was based on a total of 88 days of Applicant Delay. The record indicates Applicant Delay should be increased from 88 days to 202 days for the following reasons:

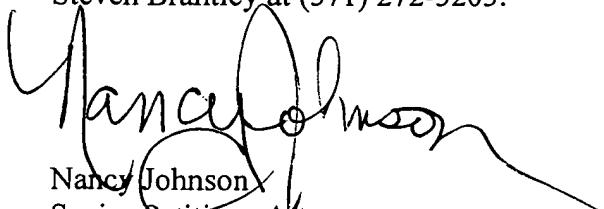
- (1) The Office should have entered a 34-day reduction, instead of a 19-day reduction, for Applicant Delay under 37 C.F.R. § 1.704(b) when responding to the May 12, 2004 Notice to File Missing Parts;
- (2) The Office should have entered a 95-day reduction, instead of no reduction, for Applicant Delay under 37 C.F.R. § 1.704(b) when responding to the September 12, 2006 non-final Office action; and
- (3) The Office should have entered a 4-day reduction, instead of no reduction, for Applicant Delay under 37 C.F.R. § 1.704(b) when responding to the May 31, 2007 Notice of Allowance.

In view of the prior discussion, the patent term adjustment is 346 days (548 days of Office Delay reduced by 202 days of Applicant Delay).

Submission of the \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged.

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **three hundred forty-six (346) days**.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Draft Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT NO. : 7,491,509 B2

ISSUE DATE : February 17, 2009

DRAFT

INVENTOR(S) : Fedorkin et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 358 days.

Delete the phrase "by 358 days" and insert - by 346 days--